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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/208,097	11/16/1998	JOHN S. HENDRICKS	5213	7677

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EXAMINER

KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/208,097

Applicant(s)

HENDRICKS ET AL.

Examiner

Andrew Y Koenig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 23-30, 34, 35, 38-90, 93-97, 101-112, 116-122, 124, 125, and 127-129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-20,23-30,34,35,38-90,93-97,101-112,116-122,124,125 and 127-129.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-20, 23-30, 34, 35, 38-90, 93-97, 101-112, 116-122, 124, 125, and 127-129 have been considered but are moot in view of the new ground(s) of rejection.

In the final rejection mailed 09 April 2003, paper 13, The examiner indicated allowable subject matter, specifically the limitations of "using a heuristic in the operations center to automatically generate menus," where heuristic is defined by Webster's as: "involving or serving as an aid to learning, discovery, or problem-solving by experimental and esp. trial-and-error methods."

The examiner expresses appreciation for canceling problem claims and addition to overcoming the double patenting rejection. However, the examiner regrets to withdraw the previously allowed claims, in that a U.S. Patent 5,075,771 to Hashimoto teaches an algorithm which automatically generates program lists for the user using an iterative process at the headend, see col. 7, ll. 20-62. Specifically, Hashimoto teaches a $P_c(j)$ term which is a coefficient calculated through a feed back from subscribers, which is serving as a problem-solving technique by experimental techniques that changes with user input. As best determined by the examiner by means of the applicant's specification, Hashimoto teaches a heuristic.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

This application repeats a substantial portion of prior Application No. 08/912,934 filed 15 August 1997, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Specifically, claims 117 and 118 recite the limitations of a subscription including on-line services and data services. The parent applications fail to recite the claimed limitations; accordingly, claims 117 and 118 will be treated as claims filed 16 November 1998 (the filing date of the instant application).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-6, 10-20, 27-30, 38, 39, 43-45, 52-56, 60, 62-67, 66-67, 69-80, 93-85, 108-112, 117-120, 122, and 124-129 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,477,262 to Banker et al. in view of U.S. Patent 5,479,266 to Young et al. and U.S. Patent 5,075,771 to Hashimoto.

Regarding claims 1, 3, 62, 64, 69-72, 101, 108, 119, 120, and 127, Banker teaches packaging programs and distributing them, where the packaging includes at least one program (col. 8, ll. 45-60), generating and providing menu information (col. 13, ll. 35-61; fig. 7-20), by means of menu screens, on-screen displays (OSDs), and messages. Banker teaches a terminal that stores menu information (col. 9, ll. 42-51), displays menu information (fig. 7-20), choosing a program from the displayed menu (fig. 13A, screens 32b and 32c), receiving the program, but is silent on switching. Young teaches choosing a program from a displayed menu, receiving the program, and switching the terminal (col. 7, ll. 24-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using a displaying a menu, receiving the program, and switching as taught by Young in order to conveniently display and select programs to the user. Banker teaches menus related to a pay-per-view service (see fig. 6E, 6F, 12, 13a, 13b), which reads on the broadest

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reasonable interpretation of interactive service and a data services. Furthermore, Banker teaches transmitting the menu data for the interactive services and data services to the user (col. 8, ll. 45-60). Banker is silent on using a heuristic to determine the content of a menu. Hashimoto teaches using a heuristic, see col. 7, ll. 20-62. Specifically, Hashimoto teaches a $P_c(j)$ term which is a coefficient calculated through a feed back from subscribers, which is serving as a problem-solving technique by experimental techniques that changes with user input. As best determined by the examiner by means of the applicant's specification, Hashimoto teaches a heuristic. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using a heuristic as taught by Hashimoto in order to properly identify programming for the user based on the relationship from one person to the group of people thereby providing programming more indicative to the user.

Regarding claims 38, 39, 52, and 55, see claim 1, Banker is silent on scrolling. Young teaches scrolling (col. 2-3, ll. 55-14), which allows the menu to exceed the size of the display. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using scrolling as taught by Young in order to provide and access information that is not currently displayed.

Regarding claims 4-6, 66-67, 85, and 89-90, Banker cable headend (fig. 1), which reads on an operations center, but is silent on a satellite receiver. Official Notice is taken that backyard satellite receivers are notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to modify Banker by using a satellite receiver in order to receive a video signal in an area not accessible via cable.

Regarding claims 10-13, 53, 54, and 73, Banker is silent on highlighting using the cursor (fig. 7a), but is silent on designating the highlighted program as the chosen program. Young teaches selecting a program (col. 7, ll. 24-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using a displaying a menu, receiving the program, and switching as taught by Young in order to conveniently display and select programs to the user. Banker is silent on scrolling. Young teaches scrolling (col. 2-3, ll. 55-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using scrolling as taught by Young in order to provide and access information that is not currently displayed. Banker teaches an IR remote (fig. 3, label 312), to navigate the programming menu, and a select button (see fig 5), which equates to the claimed go button.

Regarding claims 14 and 74, Banker is silent on updating the menus. Young teaches updating (col. 5, ll. 57-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by updating the guide as taught by Young in order to display current and accurate information to the users.

Regarding claims 15 and 75, 102-106, Banker is silent on the programming menu including a video window. Young teaches the use of a video window in the programming menu (see figures 9-10). Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify Banker by providing a video window as taught by Young in order to uninterrupted viewing of a program while browsing through the programming menus.

Regarding claims 16-18, and 76-80, Banker is silent on video advertisements targeted to a viewer based on demographic information. Official Notice is taken that advertisements targeted to a viewer based on demographic information are notoriously old and well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by displaying advertisements targeted to a viewer based on demographic information in order to target the audience, which increases its effectiveness.

Regarding claim 19, Banker and Young are silent on displaying an advertisement prior to the display of the chosen program. Official Notice is taken that displaying an commercial/advertisement prior to displaying the chosen program is well known in the art, such as displaying a preview period for a desirable pay-per-view movie. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by displaying ads prior to a selection in order to help ensure that advertisements are viewed and promote a service/product.

Regarding claims 20, 116, and 121, Banker teaches pay-pay-view programming (figs. 13a, 13b) which reads on a connection to alternate programming and mini-pay.

Regarding claim 23, 83-84, and 93, Banker is silent on teaching receiving information over fiber-optic and cable. Official Notice is taken the receiving information of different transmission mediums is well known in the art. Therefore, it would have

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been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using cable or fiber optic cable in order to provide a diverse system.

Regarding claims 27-28, 94-95, and 109-110, Banker teaches pay-pay-view programming (figs. 13a, 13b) which reads on specialty channel subscription.

Regarding claims 29-30, 96, 97, 111, 112, 122, and 124-125, 128, 129, Banker is silent on teaches monthly and annual, first-run movie channel, sporting, full season and partial season, or favorite team subscription. Official Notice is taken that these different revenue models are old and well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using these subscription techniques in order to encourage viewers to watch shows that interest them and generate revenue for the supplier.

Regarding claim 43, Banker teaches messages, which reads on the program control information signal.

Regarding claim 44, Banker is silent on using the vertical blanking interval (VBI). Young teaches using the VBI (col. 12, ll. 64-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using VBI as taught by Young in order to make efficient use of the available bandwidth.

Regarding claim 45, Banker and Young are silent on a dedicated channel. Official Notice is taken that using a dedicated channel is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young to use a dedicated channel in order to provide a higher bandwidth signal downstream to the users.

Regarding claim 56, Banker and Young are silent on using the controls on the terminal. Official Notice is taken that using controls on a terminal are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by using controls on the terminal in order to navigate through the menus.

Regarding claims 63 and 107, Banker is silent on using virtual channels. Official Notice is taken that virtual channels are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using a virtual channel in order to provide information easily to the user, thereby allowing a channel selection to view information.

Regarding claims 117 and 118, the parent application fails to support the limitations addressed these claims. Accordingly, the effective date of the claims is 3 November 1998. Further regarding claims 117 and 118, Banker is silent on subscription online and data services. Official Notice is taken that subscriptions to online and data services are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by receive online and data subscriptions in order to provide the user with requested information thereby enabling the user to access more information conveniently.

5. Claims 2, 46-51, 57, 61, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,477,262 to Banker et al., U.S. Patent 5,479,266 to

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Young et al., and U.S. Patent 5,075,771 to Hashimoto in view of U.S. Patent 5,001,554 to Johnson et al.

Regarding claims 2, 46, 47, and 65, Banker and Young are silent on transmitting menu templates. Johnson teaches sending menu template for menu data (col. 11, ll. 41-58) and storing in memory. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by using templates as taught by Johnson in order to provide the user with a current menu, which allows for menu modifications and thus diversifies the system and increases robustness.

Regarding claim 48, Banker and Young are silent on an introductory menu template, a home menu templates, major menu templates, and submenu templates. Official Notice is taken that using a variety of menus is notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by using a variety of menu templates, such as an introductory menu template, a home menu templates, major menu templates, and submenu templates in order to provide the user with a friendly, and easy to navigate system.

Regarding claims 49 and 51, Young teaches a list of categories (figs. 14-17).

Regarding claim 50, Young teaches a list of program titles (see figure 1).

Regarding claim 57, Banker teaches a notification menu (fig. 11), escape menus, and return to program menus (fig. 7A). Banker and Young are silent on a program description menu. Official Notice is taken that using a variety of menus is notoriously

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well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by using a menu, such program description menu in order to provide the user with information pertaining to the programs.

Regarding claim 61, Banker teaches canceling from a menu, see figures 6F, 7A, 9, 11, 13A, 15A-15C, 17A-17J, 19A-19E, and 20A-20B.

6. Claims 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,477,262 to Banker et al., U.S. Patent 5,479,266 to Young et al., U.S. Patent 5,075,771 to Hashimoto, and U.S. Patent 5,001,554 to Johnson et al. in view of U.S. Patent 5,367,330 to Haave et al.

Regarding claim 58, Banker teaches a system providing services to pay per view (fig. 13A, 13B), but is silent on a program description, preview window, and cost to order. Young teaches using program descriptions, a preview window (fig. 10), but is silent on a cost to order. Haave teaches charging for services (fig. 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the cost of the services as taught by Haave in order to allow the user to effectively determine the price of the service.

Regarding claims 59 and 60, Banker is silent on highlighting using the cursor (fig. 7a), but is silent on designating the highlighted program as the chosen program. Young teaches selecting a program (col. 7, ll. 24-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by

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using a displaying a menu, receiving the program, and switching as taught by Young in order to conveniently display and select programs to the user. Banker is silent on scrolling. Young teaches scrolling (col. 2-3, ll. 55-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using scrolling as taught by Young in order to provide and access information that is not currently displayed. Banker teaches an IR remote (fig. 3, label 312), to navigate the programming menu, and a select button (see fig 5), which equates to the claimed go button.

7. Claims 7-9, 34, 35, 40-42, 58, 68, 86-90, 93-97, and 101-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,477,262 to Banker et al., U.S. Patent 5,479,266 to Young et al., and U.S. Patent 5,075,771 to Hashimoto in view of U.S. Patent 5,367,330 to Haave et al.

Further regarding claims 8-9, 34, 40, 41, and 87, see claim 1, Young teaches program name, start time, duration (figs. 1-4), and a category (figs. 14-17). Haave teaches setting a price (col. 11, ll. 13-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by setting a price for programs as taught by Haave in order to provide information for pay-per view services to the user and enable them to purchase the service.

Regarding claim 7, Banker and Young are silent on an operation center that transmits data to the headend. Haave teaches an operational center (fig. 1), which inserts local programming and menu information (fig. 5). Therefore, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by using an operational center as taught by Haave in order to adapt the programming specifically for the users.

Regarding claim 35, Banker teaches a headend controller performing continuous refreshes interactive services and data (col. 8, ll. 28-35); clearly the system of Banker collects the information in order to send for transmission. Banker teaches a displaying authorized pay-per-view events (see fig. 13A, screen 32b), additionally, Banker teaches a database in the billing computer (col. 7, ll. 60-63) which reads on inventorying the interactive and data services to be made available to the viewer. Banker teaches a system control computer that configures tuning frequencies of the channels provided to the subscribers, which includes pay-per-view, which reads on interactive and data services. Banker displaying menu data for interactive services and data services (see fig. 13A), clearly the system of Banker must create menu data in order to format the data and send it downstream to the viewer. As per the discussion of claim 35, the examiner could not determine a reasonable interpretation of the limitation "determining a method of upstream transmissions for the interactive and data services" and accordingly no art rejection for that specific limitation can be made.

Regarding claims 42, 86, and 88, Banker and Young are silent on digital programs. Official Notice is taken that digital signals are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young to utilize digital programs in order to transmit high quality signals.

Regarding claim 68, Banker and Young are silent on transmitting menu information and programming to the headend, and inserting the information. Haave teaches generating menus and a digital signal from an operation center (figure 1), see col. 2, ll. 41-69, col. 8, ll. 24-39, and col. 9-10, ll. 11-50. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by generating menus and inserting information as taught by Haave in order to compile information from a plurality of sources and centralizing the information, thereby providing better use of resources and information to the users.

Regarding claims 89, 90, 93-97, and 101-107, the basis of this rejection is discussed in preceding claims rejected over Banker in view of Young and Hashimoto.

8. Claims 24-26 and 81-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,477,262 to Banker et al., U.S. Patent 5,479,266 to Young et al., and U.S. Patent 5,075,771 to Hashimoto in view of U.S. Patent 5,381,477 To Beyers, II et al.

Regarding claims 24-26 and 81-82 Banker and Young are silent on sending information to an online address and coupling the online address to the terminal. Beyers teaches sending information directly to addressed terminals (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by sending information to an online address coupled to the terminal in order to provide customized information to the user.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

ayk


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